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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,005	01/22/2004	Ronald B. Odlich	J53-011 CON	6228

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NOTARO AND MICHALOS
100 DUTCH HILL ROAD
SUITE 110
ORANGEBURG, NY 10962-2100

EXAMINER

WILSON, JOHN J

ART UNIT PAPER NUMBER

3732

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,005	Applicant(s) ODRICH ET AL.	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application was filed with claims 1-10 and 12-15, claim 11 is missing. As such, the examiner has renumbered claims 12-15 to be claims 11-14 respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day (5947735) in view of Somborac (5636989) and Wimmer et al (5302126). Day shows a lower portion 20, thread 22, and textured surface, column 2, lines 17-24. Day further shows a smooth collar 16, however, does not show a polished collar. Somborac teaches using a polished smooth collar 22, column 3, lines 55-65. It would be obvious to one of ordinary skill in the art to modify Day to include a polished collar as shown by Somborac in order to better hold the anchor within the tissue. The above combination does not show a bore with a threaded bore portion. Wimmer teaches using a bore 28 with a threaded bore portion 26. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bore and threaded bore portion as shown by Wimmer in order to better mount the prosthesis on the implant. As to claim 2, Day shows a toe recess 26. As to claims 3, 4, 10 and 11, Somborac shows a textured surface 18 below the polished surface 22. It would be obvious to one of ordinary skill in the art to modify the above combination to include a textured surface below the polished surface as shown by

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Somborac in order to make use of known structures to best hold an implant in tissue. As to claim 5, Wimmer shows a female taper at 28. As to claim 9, Day shows a non-threaded portion, see below collar 16. As to claim 12, see screw 30 of Wimmer. As to claim 13, see abutment 40 with portion 45 for extending into the bore and screw 30 of Wimmer.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Day (5947735) in view of Somborac (5636989) and Wimmer et al (5302126) as applied to claims 1 and 5 above, and further in view of Carmichael et al (6126662). The above combination shows the structure as described above and further shows a taper 28, however, does not show a Morse taper. Carmichael teaches a Morse taper, column 7, lines 5-13. It would be obvious to one of ordinary skill in the art to modify the above combination to include a Morse taper as shown by Carmichael in order to better hold the elements together.

Claims 7, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day (5947735) in view of Somborac (5636989) and Wimmer et al (5302126) as applied to claim 1 above, and further in view of Niznick (5281140). The above combination shows the structure as described above, however, does not show a polygonal receiving bore. Niznick teaches a polygonal receiving bore 12. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bore as shown by Niznick in order to better attach the elements together.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,733,292. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not include a contiguous neck, a wrench engaging surface or an orientation means are obvious matters of choice in not using specific limitations to one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, line 2, "the neck", in claim 6, lines 1 and 2, "the female taper", and in claim 8, line 2, "the platform" all lack proper antecedent basis within the claims.

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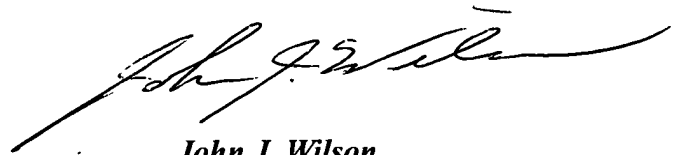
Drawings

The drawings filed January 22, 2004 have been found to be acceptable by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coatoam (5246370) shows a polygonal receiving bore.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, appearing to read "John J. Wilson", with a long horizontal flourish extending to the right.

John J. Wilson
Primary Examiner
Art Unit 3732

jjw

August 6, 2004

Fax (703) 872-9306

Work Schedule: Monday through Friday, Flex Time